



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Diane C. Breidenbach

SERIAL NO.: 09/842,371

FILED: April 25, 2001

FOR: DUAL COSMETIC CONTAINER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

State of New York)
) ss.:
County of Suffolk)

Diane Breidenbach being duly sworn deposes and says that:

1. She is CEO of Fragrance Systems Inc., the assignee of the above identified application. I have been in the business of designing and selling packaging for cosmetic products including perfume since 1992.
2. As part of my duties as CEO of Fragrance Systems Inc. I have become familiar with competing perfume bottles and cosmetic packaging in general in the market place.
3. I have reviewed United States Design Patent No. D164,327 to Roehrich. In the years that I have been in the business of selling containers for perfume and other cosmetic products, I am not aware of any product sold that was identical to the bottle shown in the Roehrich patent, United States Design Patent No. 164,327.
4. I note that the Roehrich patent issued in 1951, over fifty years ago. I have been informed that the Roehrich patent expired in 1965, over 40 years ago.

5. Since the design was in the public domain for over 40 years any cosmetic or perfume company could sell the design shown in the Roehrich design patent. No one to my knowledge has done so.

6. Claim 1 of the above application provides covers

“A dual ended container comprising a sleeve that has a first end and a second end, said first and second ends having a generally circular cross section along the entire length of said sleeve, and wherein the diameter of said sleeve does not vary its length each of said ends being adapted to receive a receptacle for containing a product and wherein the first receptacle has a means for applying a product that is different from the means for applying a product in the second receptacle and at least one of the receptacles is a container having a first end and a second end, at least one end of said receptacles having a rollerball applicator for dispensing product from said receptacle, said end of said receptacle having said rollerball applicator being removably connected to one end of said sleeve said second end of said sleeve having, a rod extending therefrom and wherein said rod has a doe foot applicator attached thereto, said rod extending from generally the center of the orifice formed by said sleeve, said second end further having a receptacle removably connected to said sleeve, and wherein said receptacles are generally circular in cross section, said receptacles having a diameter and wherein the diameter of said first receptacle and said second receptacle are generally the same diameter as the diameter of said sleeve and wherein said receptacles have a sidewall and wherein said sidewall of the first receptacle is generally parallel to the sidewall of the second receptacle.”

7. As can be seen from claim 1, this claim covers a Dual Cosmetic Container having a shape shown in Figure 7 of the patent application, a copy of which is attached hereto, as Exhibit 13.

8. Claim 1 covers a product sold by Fragrance Systems since 2001. Since the product was introduced by Fragrance Systems, Inc. in 2001, it has achieved widespread customer recognition in the marketplace, because of its unique features.

9. The compact lines of the article of the present application provides an end user with important benefits. Many women desire to reapply lip products over the course of

the day or evening to refresh themselves. In addition, many women also like to reapply perfume at various times. The present invention permits these women to accomplish this because the dual containers. The present invention is also compact and permits women to refresh themselves in two ways using a single package. The package of the present invention also has a great deal of portability due to its compact nature. The present invention fits readily in a purse or handbag yet leaves room for other items as well. The Roehrich package is a dual perfume container which does not have two different products present. Roehrich teaches or suggests that the same product be packaged in both ends of the dual container. Such an arrangement defeats the major benefits of the present invention set forth above.

10. The present invention also achieves significant benefits for the cosmetic companies as well. Many women have a particularly favorite fragrance that they buy regularly. A cosmetic company using the present invention can provide the desired fragrance in one receptacle. In the other receptacle, the company can provide another product that the cosmetic company would like to sell to the consumer. The dual container permits the cosmetic company to provide the customer with a sample of the new product when the fragrance is purchased thus making it attractive for the customer to buy the dual container since the customer is receiving two different products in a single compact article.

11. Fragrance Systems has done no advertising or promotion of the subject matter of the above identified application.

12. Fragrance Systems does not have manufacturing facilities and must depend on third parties to manufacture the product, which is the subject matter of the above

identified application. As a result, Fragrance Systems manufacturing costs can be higher than competitors that manufacture competing products themselves. In addition, the cost of the packaging is only a small part of the overall price of the product being sold. As a result the selling price of a container is not the paramount issue when a cosmetic company decides to use a particular container. The look of the container and the features of the container are of primary importance.

13. There are many different perfume containers that are possible for storing perfume. Attached hereto are representative samples of patents and commercially available products showing a wide variety of containers, see attached Exhibit 14.

In a brief internet search over 475 different types of containers were uncovered. It will also be appreciated that there are countless other possible containers for perfume and the like.

14. In view of the endless number of possible perfume containers that are available for perfume manufactures and cosmetic companies to use many different packages have limited runs or are not sold in large quantities.

15. In my fourteen years of experience in designing containers for cosmetics, including perfume, I have found that cosmetic companies and perfume manufactures will select only packaging that distinguishes their products from others in the market place. Packaging in the cosmetic area is an important factor for a cosmetic company because it gives a look that the marketing arm of the cosmetic company wants their product to achieve.

16. The product of the present invention has been selected by cosmetic companies to package their products because of the combination of a roller ball applicator for

perfume and the like and a second receptacle that has a means for applying a product that is different from the roller ball. The second receptacle can include a doe foot applicator which is the subject of the claim. These features combined with the unique shape that is claimed by the Applicant have provided cosmetic companies with a product that is completely different from the design shown in the Roehrich patent US Patent No. D164,327.

17. Many well known cosmetic companies have become customers of Fragrance Systems and have included the dual cosmetic container having a roller ball and a doe foot applicator in their product lines. These cosmetic companies include such major companies as Estee Lauder, Mary Kay, Avon, Proctor & Gamble, Elizabeth Arden, Clinique, Britney Spears line, The Body Shop, Victoria's Secret and Hard Candy. These companies have chosen to sell the product of the present invention because of its unique features.

18. Fragrance Systems' customers have promoted the product of the present application to the public. For example, the dual cosmetic container having a roller ball and a doe foot applicator of the present invention have been featured by Victoria's Secret Christmas 2002 Catalog and Victoria's Secret Christmas 2003 Catalog. Copies of relevant portions of Victoria's Secret Christmas 2002 and 2003 Catalogs are attached hereto as Exhibits 1 and 2.

19. At the 2004 Academy Awards presented by the Academy Motion Picture Arts and Sciences, Victoria's, a customer of Fragrance Systems for the product of the application, used the dual cosmetic container of the above identified application as a gift for the attendees to the ceremony. Attached hereto as Exhibit 3 is a copy of an article

from the March 21, 2004 issue of Newsday showing the dispenser of the present invention as part of the Oscar Nominee Gift Pack for the 2004 Academy Awards ceremony.

20. Estee Lauder has advertised Applicant's product. Attached hereto as Exhibit 4 is a copy of an Estee Lauder advertisement offering Applicant's dual cosmetic container.

21. Attached hereto as Exhibit 5 is a copy of Bloomingdale's promotion for the dual cosmetic container of the present invention as part of a Mother's Day gift package.

220. Attached hereto as Exhibit 6 is a page from the Mary Kay website showing the dispenser of the present invention as part of the Mary Kay "Velocity" product line.

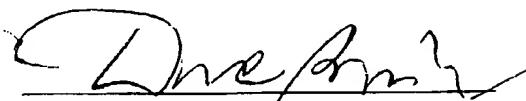
23. Sephora's Britney Spears product line includes the dispenser of the present invention, attached hereto as Exhibit 7 is a copy of the www.sephora.com website showing applicant's product.

24. Seventeen Magazine ran an article entitled "Wallet Size Lip Gloss, Clump Free Mascara and More I Gotta-Have-Em Tidbits by Laura Kinney." Item three in the article is directed to Applicant's product where the author states "Talk about bang for your buck, The Body Shop's Tint & Shine Packs Three Functions in One Handy Wand". See Exhibit 8.

25. The dual cosmetic container of the present application has been shown a number of times in publications in the form of advertisements for the product sold by Hard Candy. Attached hereto are Exhibits 9-12 which show the Applicant's product as marketed by its customer Hard Candy under the designation Stain & Shine.

26. Since the product was introduced in 2001, Applicant has been a commercial success in the cosmetic industry. Fragrance Systems has sold over 4,000,000 dual ended roller ball/doe foot applicator packages of the present invention.

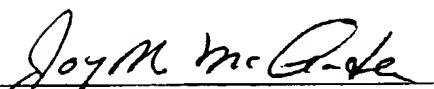
27. These are a significant number of sales in a market crowded with competitive containers and reflect the uniqueness and unobviousness of the applicant's container compared to the prior art Roehrich.



Diane Breidenbach

Sworn to before me this
28 day of August 2006

Joy M. McArdle
Notary Public - State of New York
No. 01MC6008320
Qualified in Suffolk County
My Commission Expires June 08, 2010



Joy M. McArdle
Notary Public
